

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/992,222	12/17/97	HOBBS	W INPA:056

WILLIAM W. KIDD
BLAKELY, SOKOLOFF
TAYLOR & ZAFMAN, LLP
12400 WILSHIRE BLVD., 7TH FLOOR
LOS ANGELES CA 90025

LM02/1126

EXAMINER

PANCHOLI, J

ART UNIT	PAPER NUMBER
2781	7

DATE MAILED: 11/26/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/992,222	Applicant(s) William A. Hobbs et al
Examiner Jigar Pancholi	Group Art Unit 2781

Responsive to communication(s) filed on Sep 7, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

Claim(s) 1-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1-28 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-28 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The use of the term “native bus transaction” is new matter because it was never discussed in the original Specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit:

The term “native bus transaction” is not understood by the examiner. After looking at the Specification, there is not support for a “native bus transaction” and thus the examiner is having difficulty understanding what is meant by the term.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371C of this title before the invention thereof by the applicant for patent.

6. Claims 1, 2, 4-6 and 9-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gates (5,701,409).

- a. As for claims 1, 2, 16, 21, 22 and 25-28, Gates teaches a system to test a bus comprising at least one instruction memory to store a predefined bus stimuli instruction and at least one phase generator coupled between the bus and the instruction memory for providing signals to the bus in response to the predefined bus stimuli instruction (abstract).
 - b. As for claim 4, it is inherently seen that the IC (phase generator) can also receive signals from the bus.

Art Unit:

- c. As for claims 5, 17 and 23, it is inherently seen that some type of storing of predefined responses must be included for the device to compare results to detect errors.
- d. As for claims 6 and 18, Gates teaches the phase generator includes one digital logic device responsive to the instructions and one phase engine for controlling timing (abstract; col. 2, lines 40-45).
- e. As for claims 9 and 19, Gates teaches a control portion and data portion (col. 5, lines 27-45).
- f. As for claim 10, Gates inherently teaches the control portion includes a flow logic device.
- g. As for claim 11, Gates inherently teaches the phase engine includes at least one logic level translation device.
- h. As for claim 12, it is inherently seen that these phases are included since a PCI bus includes these phases.
- i. As for claims 13, 14, 20 and 24, Gates teaches a data memory coupled to the data portion and that the data portion receives data from the bus (col. 5, lines 27-45).
- j. As for claim 15, Gates teaches a system to test a bus comprising at least one instruction memory to store a predefined bus stimuli instruction and at least one phase generator coupled between the bus and the instruction memory for providing signals to the bus in response to the predefined bus stimuli instruction (abstract).

Art Unit:

It is inherently seen that the IC (phase generator) can also receive signals from the bus. It is inherently seen that some type of storing of predefined responses must be included for the device to compare results to detect errors. Gates teaches the phase generator includes one digital logic device responsive to the instructions and one phase engine for controlling timing (abstract; col. 2, lines 40-45). Gates teaches a control portion and data portion (col. 5, lines 27-45). Gates inherently teaches the control portion includes a flow logic device. Gates inherently teaches the phase engine includes at least one logic level translation device. Gates teaches a data memory coupled to the data portion and that the data portion receives data from the bus (col. 5, lines 27-45).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
8. Claims 3, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gates (5,701,409).
 - a. As for claim 3, Gates inherently teaches the instruction comprises an instruction word (col. 2, lines 40-45). Gates doesn't teach that the instruction word has a

Art Unit:

predefined length. Official Notice is taken that instruction words of predefined lengths are well known in the art. It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used instruction words of any length because they are only a matter of computer design.

- b. As for claims 7 and 8, Gates doesn't teach what the digital logic device comprises. Official Notice is taken that FPGA's and ASIC's are well known in the art. It would have been obvious to a person of ordinary skill in the art, at the time of the invention, to have used instruction words of any length because they are only a matter of computer design.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art made of record (please see PTO-892) teaches bus and system testing.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jigar Pancholi whose telephone number is (703) 306-3012. The examiner can normally be reached on Monday through Thursday from 7:00 to 4:30. The examiner can also be reached on alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh, can be reached on (703) 305-9648. The fax phone number for Formal or Official faxes for this Group is

Art Unit:

(703) 308-9051 or (703) 308-9052. The fax phone number of informal or drafts is (703) 305-3718. Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [ayaz.sheikh@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



AYAZ R. SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700

JKP
11/19/99